



Attorney Docket No. 000396

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JACOBS, et al.

Serial No.: 09/732,158

Filed: December 7, 2000

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Art Unit: 2143

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MAY 06 2004

Technology Center 2100

Docket No. 000396

For: **E-MAIL SOFTWARE AND METHOD AND SYSTEM FOR DISTRIBUTING ADVERTISEMENTS TO CLIENT DEVICES THAT HAVE SUCH E-MAIL SOFTWARE INSTALLED THEREON**

CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail, in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450

April 30, 2004
Date

Tami M. Proppio

Tami M. Proppio

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit herewith, in accordance with 37 CFR § 1.98, the patents, publications and other information listed on the enclosed Form PTO-1449.

The references submitted herewith are those of which Applicants are aware, which they believe may be material to the examination of this application and, with respect to which there may be a duty to disclose in accordance with 37 CFR § 1.56. While the references identified may be material to the examination of this application pursuant to 37 CFR § 1.56, the citation of these references is not intended to constitute an admission that any reference referred to herein is prior art to the invention of this application, unless specifically designated as such. Additionally, the filing of this Information Disclosure Statement shall not be construed to mean that any search has been made or, that if made, such search was complete or exhaustive, or that no other material information as defined in 37 CFR § 1.56 exists.

In accordance with 37 CFR § 1.97(b)(3), this Information Disclosure Statement is being submitted before mailing of the first Office Action on the merits.

A list of the references is set forth on Form PTO-1449, which is enclosed herewith, along with a copy of each cited reference. Applicants respectfully request that the Examiner return to Applicants a copy of the Form PTO-1449 indicating consideration of the references cited thereon.

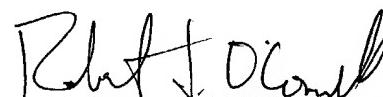
References A26, B8, and C1 were forwarded to the applicants by the Office in two Notifications identifying prior art submitted in late protests in co-pending applications 09/728,651 and 09/732,158.

Applicants do not believe that any fees are due. If, however, it is determined that fees are owed, Applicants hereby authorize that such fees be charged to Deposit Account No. 17-0026.

Respectfully submitted,

Date: April 30, 2004

By:



Robert J. O'Connell
Reg. No. 44,265
(858) 651-4361

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714

Telephone: (858) 658-5787
Facsimile: (858) 658-2502



PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

16 plus
2 w/ JN

Application Number

09/732,158

Filing Date

December 7, 2004

First Named Inventor

Paul E. JACOBS

MAY 06 2004

Art Unit

2143

Examiner Name

Not yet assigned

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Attorney Docket Number

000396

ENCLOSURES (Check all that apply)

- Fee Transmittal Form
- Fee Attached
- Amendment/Reply
- After Final
- Affidavits/declaration(s)
- Extension of Time Request
- Express Abandonment Request
- Information Disclosure Statement; PTO Form 1449
- Certified Copy of Priority Document(s)
- Response to Missing Parts/ Incomplete Application
- Response to Missing Parts under 37 CFR 1.52 or 1.53

- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s) _____

- After Allowance Communication to Group
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter
- Other Enclosure(s) (please identify below):
References (46)
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Remarks

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------|--|
| Firm or Individual name | QUALCOMM, INC. Robert J. O'Connell - 44,265 |
|-------------------------|--|

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| Signature | |
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| Date | April 30, 2004 |
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Dated: 4/30/04Signature: Tami M. Procopio (Tami Procopio)

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Sheet 1 of 2

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|--|--|-----------------------------|---------------------------------------|
| FORM PTO-1449 (REV. 7-80) | U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | ATTY. DOCKET NO. 000396 | SERIAL NO. 09/732,158 |
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use several sheets if necessary)</i> | | APPLICANT JACOBS, et al. | MAY 06 2004 Technology Center 2100 |
| DATE MAILED: April 30, 2004 | | FILING DATE 12/07/2000 | GROUP/EXAMINER 2143 |

U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | DOCUMENT NUMBER | | | | | | | | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROPRIATE |
|------------------|-----------------|---|---|---|---|---|---|----------|--------------------|------|--------|-----------|----------------------------|
| A1 | 6 | 0 | 1 | 4 | 5 | 0 | 2 | 1/11/00 | Moraes | 395 | 200.49 | | |
| A2 | 5 | 9 | 5 | 9 | 6 | 2 | 3 | 9/28/99 | van Hoff et al. | 345 | 333 | | |
| A3 | 5 | 9 | 4 | 6 | 6 | 4 | 6 | 8/31/99 | Schena et al. | 702 | 177 | | |
| A4 | 5 | 9 | 3 | 7 | 3 | 9 | 2 | 8/10/99 | Alberts | 705 | 14 | | |
| A5 | 5 | 9 | 1 | 3 | 0 | 4 | 0 | 6/15/99 | Rakavy et al. | 395 | 200.62 | | |
| A6 | 5 | 8 | 4 | 8 | 3 | 9 | 7 | 12/8/98 | Marsh et al. | 705 | 14 | | |
| A7 | 5 | 8 | 3 | 8 | 7 | 9 | 0 | 11/17/98 | McAuliffe et al. | 380 | 4 | | |
| A8 | 5 | 8 | 1 | 2 | 7 | 8 | 4 | 9/22/98 | Watson et al. | 395 | 200.57 | | |
| A9 | 5 | 8 | 0 | 9 | 2 | 4 | 2 | 9/15/98 | Shaw et al. | 395 | 200.47 | | |
| A10 | 5 | 7 | 9 | 4 | 2 | 1 | 0 | 8/11/98 | Goldhaber et al. | 705 | 14 | | |
| A11 | 5 | 7 | 8 | 1 | 8 | 9 | 4 | 7/14/98 | Petrecca et al. | 705 | 14 | | |
| A12 | 5 | 6 | 6 | 4 | 9 | 4 | 8 | 9/9/97 | Dimitriadis et al. | 434 | 307 | | |
| A13 | 5 | 5 | 1 | 5 | 2 | 7 | 0 | 5/7/96 | Weinblatt | 364 | 405 | | |
| A14 | 5 | 4 | 8 | 3 | 4 | 6 | 6 | 1/9/96 | Kawahara et al. | 364 | 514 | | |
| A15 | 5 | 4 | 7 | 5 | 8 | 1 | 9 | 12/12/95 | Miller et al. | 395 | 200.03 | | |
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| A17 | 5 | 4 | 5 | 1 | 9 | 9 | 8 | 9/19/95 | Hamrick | 348 | 13 | | |
| A18 | 5 | 4 | 4 | 2 | 7 | 7 | 1 | 8/15/95 | Filepp et al. | 395 | 650 | | |
| A19 | 5 | 4 | 2 | 6 | 4 | 2 | 7 | 6/20/95 | Chinnock et al. | 340 | 827 | | |
| A20 | 5 | 3 | 7 | 7 | 3 | 5 | 4 | 12/27/94 | Scannell et al. | 395 | 650 | | |
| A21 | 5 | 3 | 4 | 7 | 6 | 3 | 2 | 9/13/94 | Filepp et al. | 395 | 200 | | |
| A22 | 5 | 3 | 2 | 5 | 3 | 1 | 0 | 6/28/94 | Johnson et al. | 364 | 514 | | |
| A23 | 5 | 1 | 7 | 7 | 6 | 8 | 0 | 1/5/93 | Tsukino et al. | 364 | 401 | | |
| A24 | 5 | 1 | 0 | 5 | 1 | 8 | 4 | 4/14/92 | Pirani et al. | 340 | 721 | | |
| A25 | 4 | 7 | 0 | 3 | 4 | 2 | 3 | 10/27/87 | Bado et al. | 364 | 400 | | |
| A26 | 6 | 1 | 4 | 1 | 0 | 1 | 0 | 10/31/00 | Hoyle | 345 | 356 | | |
| A27 | 6 | 6 | 2 | 5 | 5 | 7 | 8 | 9/23/03 | Spaur et al. | 705 | 14 | | |
| A28 | 6 | 3 | 3 | 9 | 7 | 9 | 5 | 1/15/02 | Narurkar et al. | 709 | 246 | | |
| A29 | 6 | 6 | 5 | 8 | 4 | 6 | 5 | 12/02/03 | Touboul | 709 | 223 | | |
| A30 | 6 | 1 | 3 | 4 | 5 | 8 | 4 | 10/17/00 | Chang et al. | 709 | 219 | | |

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|--|-----|---|---|---|---|---|---|---|----------|-------------------|-----|-----|-------------|
| | A31 | 6 | 4 | 8 | 7 | 5 | 3 | 8 | 11/26/02 | Gupta et al. | 705 | 14 | |
| | A32 | 6 | 3 | 8 | 1 | 7 | 0 | 9 | 4/30/02 | Casagrande et al. | 714 | 18 | |
| | A33 | 5 | 9 | 1 | 8 | 0 | 1 | 4 | 6/29/99 | Robinson | 395 | 200 | |
| | A34 | 6 | 5 | 1 | 6 | 3 | 3 | 8 | 2/04/03 | Landsman et al. | 709 | 203 | |
| | A35 | 6 | 2 | 9 | 8 | 3 | 3 | 2 | 10/02/01 | Montague | 705 | 27 | RECEIVED |
| | A36 | 6 | 6 | 0 | 5 | 1 | 2 | 0 | 8/12/03 | Fields et al | 715 | 513 | MAY 06 2004 |
| | A37 | 5 | 9 | 5 | 5 | 7 | 1 | 0 | 9/21/99 | DiFranza | 187 | 396 | |

Technology Center 2100

FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | Ref No | DOCUMENT NUMBER | | | | | | | DATE | COUNTRY | NAME | CLASS | SUB CLASS | |
|------------------|--------|-----------------|---|----|---|---|---|---|------|----------|------|------------------|-----------|-------|
| | B1 | E | P | 8 | 2 | 2 | 5 | 3 | 5 | 2/4/1998 | EPO | Apte et al. | G09F | 27/00 |
| | B2 | W | O | 99 | 5 | 9 | 0 | 9 | 7 | 11/18/99 | PCT | Werkhoven | G06F | 19/00 |
| | B3 | W | O | 99 | 5 | 2 | 0 | 5 | 6 | 10/14/99 | PCT | Horstmann | G06F | 17/60 |
| | B4 | W | O | 99 | 1 | 3 | 4 | 2 | 3 | 3/18/99 | PCT | Middleton et al. | G06F | 17/60 |
| | B5 | W | O | 98 | 4 | 7 | 0 | 9 | 0 | 10/22/98 | PCT | Servan-Schreiber | G06F | 17/60 |
| | B6 | W | O | 97 | 4 | 0 | 5 | 1 | 4 | 10/30/97 | PCT | Shaw et al. | H01J | 13/00 |
| | B7 | W | O | 96 | 2 | 4 | 2 | 1 | 3 | 8/8/96 | PCT | Goldschmitt | H04L | 29/06 |
| | B8 | W | O | 99 | 5 | 5 | 0 | 6 | 6 | 10/28/99 | PCT | Zetmeir | H04M | 3/00 |

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Page, Etc.)

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| C1 | | Claria Company Information, Corporate Overview. www.claria.com/companyinfo 4/12/2004 |
| | | |
| C2 | | |
| | | |
| C3 | | |

EXAMINER DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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